THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte DAVID J.K. GOULAIT

_____

Appeal No. 97-4184
Application No. 08/521,256[1]

_____

ON BRIEF

_____

Before CALVERT, ABRAMS and STAAB, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

---

[1]Application for patent filed August 30, 1995. According to appellant, this application is a continuation of Application 08/137,566, filed October 15, 1993, now abandoned.

This is an appeal from the decision of the examiner finally rejecting claims 1-5 and 21-23, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to a fastening system.

The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A fastening system releasably attachable to and in combination with a complementary receiving surface, said fastening system comprising a bilaterally staggered array of free formed prongs joined at a base to an elastically extensible substrate prestrained to thereby increase the density of said prongs, said prongs extending outwardly from said substrate along a shank to an engaging means, said pre-strained substrate comprising a generally planar sheet of material and having a relaxation-extension area ratio in one direction of at least about 6.0, a five second recovery of at least 50%, and a spring rate of less than 500 grams per inch of width, whereby said prongs and said pre-strained substrate apply a preload when attached to said complementary receiving surface.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Aeschbach *et al*. (Aeschbach)	4,628,709	Dec. 16, 1986
Noel *et al*. (Noel)	5,032,122	Jul. 16, 1991

Gomez-Acevedo	5,133,112	Jul. 28, 1992
Murasaki	5,361,462	Nov. 8, 1994
		(filed Apr. 22, 1993)

THE REJECTIONS

Claims 1-5, 21 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gomez-Acevedo in view of Murasaki.

Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Gomez-Acevedo in view of Murasaki and either Aeschbach or Noel.

The rejections are explained in the Examiner's Answer.[2]

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

At the outset, pursuant to our authority under 37 C.F.R. § 1.196(b), we make the following new rejection:

[2]A rejection under 35 U.S.C. § 112, first paragraph, was withdrawn in Paper No. 21.

Claims 1-5 and 21-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

In the specification, a "prestrained" substrate has been defined as a substrate that is provided with a particular density of prongs and then "may be later activated (such as by heat shrinking) to contract" so that the density of the prongs is increased (page 6, lines 30-32). An alternative also is described, wherein a substrate "which is not thermally activated may be pre-stretched, the prongs 10 applied thereto, then released and allowed to contract" (sentence spanning pages 6 and 7). The clear implication here is that "prestraining" is a condition that exists only during the manufacturing of the substrate, that is, while the prongs are being installed, and that when this has been completed, the substrate no longer is "prestrained." The specification goes on to state that "[a] prestrained substrate . . . has the advantage of providing a preload in the product" (page 6, lines 33-34; emphasis added). This raises four issues, which also pertain to the claims. The first is that "preload" is

not defined in the specification, nor is there any indication of what structure is "preloaded." Second, it is not clear whether the "product" referred to here is the fastening system (the substrate and the prongs), to which the appellant's claims are directed, or the combination of the fastening system and the receiving surface, or something else. Third, what is meant by stating that the preload is provided "in the product" (emphasis added) is not clear. Fourth, if it is only the prestrained substrate which provides the preload, it would appear that preload is not present after the assembly of the prongs to the substrate, and therefore is not relevant to the claims, which are directed to a product and not a method of making a product.

These inadequacies in the specification become important when one attempts to determine the metes and bounds of claim 1. Because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the

possibility of infringement and dominance. It is to this that the second paragraph of 35 U.S.C. 112 is directed. See *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).

Claim 1 is directed to a fastening system comprising an array of prongs joined to an elastically extensible substrate that is "prestrained to thereby increase the density of said prongs." According to the definition of "prestrained" provided in the specification, this means that the elastically extensible substrate was stretched, the prongs were installed, and then it was allowed to contract in order to increase the density of the prongs. It therefore would appear that the prestrained condition that was present during the manufacturing process has come and gone, and is not present in the completed fastening system article, which is the subject of the claims. However, the claim goes on to state "whereby said prongs and said pre-strained substrate apply a preload when attached to said complementary receiving surface," which would seem to indicate that the prestrained condition is still in existence when the substrate is attached to the receiving surface. We are at a loss to determine what this seemingly

contradictory language means, or what effect it is intended to have upon the preceding portion of the claim.

Moreover, as we stated above, the specification provides no precise meaning to be accorded to the term "preload." And to further complicate this matter, the recitation in the specification differs from that recited in claim 1, in that the specification states that the preload is provided by the "prestrained substrate," and it acts upon "the product," a term which is not used in the claims and whose meaning is not established in the specification, while claim 1 states that the preload is provided by "said prongs and said pre-strained [prestrained?] substrate" (emphasis added).

When no definite meaning can be ascribed to certain terms in a claim, as is the case with independent claim 1, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since a rejection under 35 U.S.C. § 103 cannot be based upon speculation and assumptions, we are constrained not to sustain

the examiner's rejections. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We hasten to point out, however, that this action should not be construed as an indication that the claimed subject matter would not have been obvious in view of the prior art cited against the claims. We have not addressed this issue, for to do so would require on our part the very speculation which formed the basis of our rejection under Section 112.

SUMMARY

The rejection of claims 1-5, 21 and 23 under 35 U.S.C. § 103 as being unpatentable over Gomez-Acevedo in view of Murasaki is not sustained.

The rejection of claim 22 under 35 U.S.C. § 103 as being unpatentable over Gomez-Acevedo in view of Murasaki and either Aeschbach or Noel is not sustained.

Pursuant to 37 C.F.R. § 1.196(b), claims 1-5 and 21-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)
NEAL E. ABRAMS Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)

Larry L. Huston
The Proctor and Gamble Company
Winton Hill Technical Center
6100 Center Hill Avenue
Cincinnati, OH 45224